



05-05-03

Op 1656
#9158
5/8/03
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 00-713-i16)

In the Application of:

Chad A. Mirkin, et al.

Serial No.: 09/976,601

Filed: October 12, 2001

For: NANOPARTICLES HAVING
OLIGONUCLEOTIDES ATTACHED
THERE TO AND USES THEREFOR

Examiner: TBA

Group Art Unit: 1656

Confirmation No.: 4367

TRANSMITTAL LETTER

RECEIVED

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

MAY 07 2003

TECH CENTER 1600/2000

Sir:

In regard to the above identified application.

1. We are transmitting herewith the attached:
 - a) Seventh Supplemental Information Disclosure Statement;
 - b) U.S. PTO 1449 Form with copies of 11 references; and
 - c) Return Postcard.
2. With respect to fees:
 - a) No fees are due.
 - b) General Authorization: Please charge any underpayment or credit any overpayment our Deposit Account, No. 13-2490.
3. CERTIFICATE OF MAILING UNDER 37 CFR § 1.10: The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service as "Express Mail Post Office to Addressee", addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 2 day of May, 2003, under the Express Mail label No. EV333560902US.

Date: 5/1/03

Respectfully submitted,

Emily Miao

Registration No. 35,285



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 00-713-116)

In the Application of:

Chad A. Mirkin, et al.

Serial No.: 09/976,601

Filed: October 11, 2001

For: NANOPARTICLES HAVING
OLIGONUCLEOTIDES ATTACHED
THERE TO AND USES THEREFOR

Examiner: TBA

Group Art Unit: 1656

Confirmation No.: 4367

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RECEIVED
MAY 07 2003
TECH CENTER 1600/2900

SEVENTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Sir:

In order to comply with discretionary regulations 37 CFR §§1.97 and 1.98, attached hereto is Form PTO-1449, copies¹ of the documents listed thereon. These documents contain information which the Examiner may consider to be important in deciding whether to allow the present application to issue as a patent.

1. Heller, et al., U.S. Patent No. 4,966,143 issued 02/26/91
2. Kausch, et al., U.S. Patent No. 5,508,164 issued 04/16/96
3. Ewart, et al., U.S. Patent No. 5,922,537 issued 07/13/99
4. An, et al., U.S. Patent No. 5,972,615 issued 10/26/99

¹To the extent that a document is listed and no copy of same is attached, then such document is not at the present time available to the undersigned or is available in the file of a parent application. If a listed document is not in the English language and an English translation is readily available, such translation is also attached; if translation is not attached it is not readily available to the undersigned. If a foreign language patent document is cited, and an English language equivalent is known to the undersigned, then such equivalent patent is also cited on the attached form along with the corresponding foreign language patent and a connecting arrow indicated there between; if no such English language equivalent is cited, then none is known to undersigned.

5. Blackburn, et al., U.S. Patent No. 6,264,825 issued 07/24/01
6. Yguerabide, et al., U.S. Patent No. 6,214,560 issued 04/10/01
7. International Patent WO 94/29484 published 12/22/94
8. International Patent WO 00/25136 published 05/04/00
9. Mohanty J., et al., "Pulsed laser excitation of phosphate stabilized silver nanoparticles," *Proc. Indian Acad.*, Vol. 112, No. 1, p. 63-72 (2000)
10. Nicewarner- Peña S., et al., "Hybridization and Enzymatic Extension of Au Nanoparticle-Bound Oligonucleotides," *J. Am. Chem. Soc.*, Vol. 124, p. 7314-7323 (2002)
11. Whitesides G.M., et al., "Soft Lithography in Biology and Biochemistry," *Annu. Rev. Biomed. Eng.*, p. 335-373 (2001)

In accordance with MPEP Sections 609 and 707.05(b), it is requested that each document cited (including any cited in applicant's specification which is not repeated on the attached Form PTO-1449) be given thorough consideration and that it be cited of record in the prosecution history of the present application by initialing on Form PTO-1449. Such initialing is requested even if the Examiner does not consider a cited document to be sufficiently pertinent to use in a rejection, or otherwise does not consider it to be prior art for any reason, or even if the Examiner does not believe that the guidelines for citation have been fully complied with. This is requested so that each document becomes listed on the face of the patent issuing on the present application.

The present Disclosure Statement is being submitted in compliance with 37 CFR 1.56 insofar as an Examiner might consider any of the cited documents important in deciding whether to allow the application to issue as a patent, but the citation of each document is not to be construed as an admission that such document is necessarily relevant or prior art. No representation is intended that the cited documents represent the results of a complete search, and it is anticipated that the Examiner, in the normal course

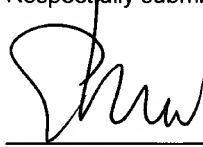
of examination, will make an independent search and will determine the best prior art consistent with 37 CFR 1.104(a) and 1.106(b) and, in the course of each search, will review for relevance every document cited on the attached form even if not initialed.

Early and favorable consideration is earnestly solicited.

Respectfully submitted,

Dated: _____

5/2/03



Emily Miao
Registration No. 35,285

McDonnell Boehnen Hulbert & Berghoff
300 South Wacker Drive, Suite 3200
Chicago, Illinois 60606
Telephone : (312) 913-0001
Facsimile: (312) 913-0002



McDonnell Boehnen Hulbert & Berghoff
Law Offices

300 South Wacker Drive
Chicago, Illinois 60606-6709
www.mbhb.com

312 913 0001 phone
312 913 0002 fax

May 2, 2003

Vijaya K. Vasista, C.O.O.
Nanosphere, Inc.
1818 Skokie Blvd
Suite 200
Northbrook, IL 60062

Re: U.S. Application No 09/976,601 for
"NANOPARTICLES HAVING OLIGONUCLEOTIDES
ATTACHED THERETO AND USES THEREFOR"
Inventor(s): Mirkin, et al.
Our Case No.: 00-713-i16

*per the order
to due at
represent
time.*

Dear VJ:

Enclosed please find a copy of a 7th Supp. Information Disclosure Statement (without references) that we prepared and filed at the U.S. Patent and Trademark Office. ~~At the present time, we are waiting to receive your instructions regarding the outstanding Office Action.~~

We look forward to hearing from you shortly. As always, please feel free to call if you have any questions regarding this matter.

Sincerely,

Emily Miao, Ph.D.
312 913 2126
miao@mbhb.com

*could keep you informed of
any future developments in
this case*

EM/vw
Enclosure